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EDWARD S IRONS
SUITE 950
700 13TH STREET N W
WASHINGTON , DC 20005

In re Application of
Daniel A. Gately et al
Serial No.: 09/016,641
Filed: January 30, 1998
Attorney Docket No.:

PETITION DECISION

This is in response to applicants' petition under 37 CFR 1.144, filed May 28, 1999, requesting withdrawal of an improper restriction requirement. The delay in acting on this petition is regretted.

A review of the file history shows that this application was filed under 35 U.S.C. 111 on January 30, 1998. The application, as filed, contains claims 1-15. The examiner in a first Office action, mailed January 7, 1999, required restriction of the claims as follows:

- Group I - Claims 1-3(in part) and 4 drawn to silyl compounds;
- Group II - Claims 1-3 (in part), 5-6 and 14-15 drawn to substituted amines;
- Group III - Claim 7 (in part), drawn to a method of making of silylated compounds;
- Group IV - Claims 7(in part) and 8, drawn to a method of making of substituted amines;
- Group V, Claims 9-13, drawn to a generic method of making a compound (a ligand).

Applicants replied on January 19, 1999, traversing the restriction requirement on a number of grounds, but electing Group V for further consideration, concluding with the statement that if the restriction requirement was modified, the provisional election of Group V was automatically voided. In an Office action mailed March 25, 1999, the examiner answered applicant's traversal of the restriction requirement, maintaining the requirement as previously set forth and examined the claims of Group V on the merits, rejecting the claims for various reasons. The restriction requirement was made final. Applicant filed this petition on May 28, 1999.

DISCUSSION

Restriction requirements in applications filed under 35 U.S.C. 111 are governed by 35 U.S.C. 121. Applicants appear to rely on the provisions of M.P.E.P. 803.02, as follows:

803.02 Restriction - Markush Claims

PRACTICE RE MARKUSH - TYPE CLAIMS

If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all claims on the merits, even though they are directed to independent and distinct inventions. In such a case, the examiner will not follow the procedure described below and will not require restriction.

Since the decisions in *In re Weber*, 198 USPQ 328 (CCPA 1978); and *In re Haas*, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention, *In re Harnish*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); *Ex Parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility and (2) share a substantial structural feature disclosed as being essential to that utility.

This subsection deals with Markush - type generic claims which include a plurality of alternatively usable substances or members. In most cases, a recitation by enumeration is used because there is no appropriate or true generic language. A Markush - type claim can include independent and distinct inventions. This is true where two or more of the members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 35 U.S.C. 103 with respect to the other member(s). In applications containing claims of that nature, the examiner may require a provisional election of a single species prior to examination on the merits. The provisional election will be given effect in the event that the Markush - type claim should be found not allowable. Following election, the Markush - type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If Markush - type claim is not allowable over the prior art, examination will be limited to the Markush - type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration.

As an example, in the case of an application with a Markush - type claim drawn to the compound C - R, wherein R is a radical selected from the group consisting of A, B, C, D, and E, the examiner may require a provisional election of a single species, CA, CB, CC, CD, or CE. The Markush - type claim would then be examined fully with respect to the elected species and any species considered to be clearly unpatentable over the elected species. If on examination the elected species is found to be anticipated or rendered obvious by prior art, the Markush - type claim and claims to the elected species shall be rejected, and claims to the non - elected species would be held withdrawn from further consideration. As in the prevailing practice, a second action on the rejected claims would be made final.

On the other hand, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush - type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush - type claim with respect to a non - elected species, the Markush - type claim shall be rejected and claims to the non - elected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all non - elected species. Should applicant, in response to this rejection of the Markush - type claim, overcome the rejection, as by amending the Markush - type claim to exclude the species anticipated or rendered obvious by the prior art, the amended Markush - type claim will be reexamined. The prior art search will be extended to the extent necessary to determine patentability of the Markush - type claim. In the event prior art is found during the reexamination that anticipates or renders obvious the amended Markush - type claim, the claim will be rejected and the action made final. Amendments submitted after the final rejection further restricting the scope of the claim may be denied entry.

The examiner set forth a restriction requirement between claims to compounds and claims to methods of making compounds. The compounds set forth in Groups I and II are patentably distinct and different compounds. The methods of Groups III and IV are based on the different compounds of Groups I and II. The method of group V is to the making of compounds not claimed in Groups I and II. Applicant appears to base his arguments primarily on the above

section of the M.P.E.P. Applicant first argues with respect to groups I and II (and later also Groups III and IV) that the examiner has no authority to base a restriction requirement on dividing claims into parts and assigning those parts to different groups of invention. However, applicant has pointed to nothing which prohibits the examiner from doing so. For example, a claim directed to a vacuum cleaner and a food processor would obviously be restricted even though each of the inventions is contained within the same claim and any restriction requirement would of necessity place only part of the claim in each invention group. In similar manner the examiner has determined that claim 1 is directed to two different and patentably distinct chemical compounds, a silyl compound composed of only carbon, hydrogen, silicon, oxygen, sulfur and possibly fluorine, and a substituted amine compound comprised of the same elements noted above and nitrogen. However, in the substituted amine compound, the focus of reactivity is at the amine site which does not exist in the silyl compounds. The compounds are therefor markedly and patentably different.

The criteria for requiring an election of species in a Markush group, as noted above, is that the compounds share a substantial structural feature disclosed as essential to the utility claimed. The examiner could find no shared substantial structural feature directed to the utility claimed and therefor a restriction requirement was made. The examiner also gave extensive reasons for restriction including basic versus acidic properties, reactivities, etc. For the same reasons, the claims directed to the making of the individual compounds, claims 7 and 8, were divided into two separate groups corresponding to the restriction of the compounds in Groups I and II. The claims of Group V are to making compounds not related to the compounds of Groups I-IV and are thus properly restrictable.

It is noted that applicant argues that the examiner must examine the "inventions" as a whole. However, the examiner has the right under 35 U.S.C. 121 to limit the claims to a single disclosed invention. By applicant's own admission (i.e. - "inventions"), there is more than one invention set forth in claim 1 and other claims. The examiner has identified which claims are related to each separate invention claimed. Obviously claim 1 relates to two inventions, as determined by the examiner, thus implying that only part of claim 1 relates to the first claimed invention and part relates to the second claimed invention. Applicant's characterization of the restriction requirement based on including parts of a claim in separate groups as illogical is not found persuasive based on the above action by the examiner. It is further noted that the method of Group V is distinguished from the methods of Groups III and IV not only by the different method steps themselves, but by the absence of a methyl sulfonyl group in the produced compound as well. Applicant's arguments have been carefully considered, but are not persuasive of error on the part of the Office.

DECISION

Applicants' petition is **DENIED**. The restriction requirement set forth by the examiner under 35 U.S.C. 121 is proper and is maintained.

Any request for reconsideration or review of this decision must be by way of a renewed petition and must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600/2900, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 308-7922.

A handwritten signature in black ink, appearing to read "John Kittle", is written over the printed name.

John Kittle

Director, Technology Center 1600/2900